

REMARKS

Claims 38-40, 43, 46-48, 52-56, 59, 62-64, 67-70, 73 and 76-84 are currently pending in the present application. Claims 41-42, 44-45, 49-51, 57-58, 60-61, 65-66, 71-72 and 74-75 have been canceled, without prejudice, and claims 38, 43, 46, 54, 59, 62, 68, 73 and 76 have been amended herein.

Claims 38, 54, and 68 have been amended to recite a carboxylic acid component comprising a mixture of two or more C<sub>5</sub>, C<sub>6</sub>, C<sub>7</sub>, C<sub>8</sub> and C<sub>9</sub> linear monocarboxylic acids. Claims 43, 46, 59, 62, 73 and 76 have been amended to correct resulting dependencies and to remove redundant references to mixtures of carboxylic acids. Support for the amendments can be found in the Specification, and the original claims. No new matter has been introduced by the amendments made herein. Additionally, a page captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE", in accordance with 37 C.F.R. §1.121(c)(1)(ii), is attached hereto. Entry of the amendments to the claims is therefore proper and respectfully requested.

In Paper No. 3, the Examiner indicates that claims 45, 51, 61 and 75 would be allowable if rewritten in independent form, incorporating all of the elements of the base claim and any intervening claims. (See, Paper No. 3, ¶6). Additionally, in Paper No. 3, the Examiner states that claims 53, and 79-80 are allowed. (See, *id.*, at ¶7).

In Paper No. 3, the Examiner rejects claims 38-44, 52, 54-60, 67-74, 77-78 and 81-84 under 35 U.S.C. §103(a), as being unpatentable over U.S. Pat. No. 5,681,800 of Duncan, *et al.* ("Duncan"), in view of U.S. Pat. No. 2,630,193 of Funkhouser ("Funkhouser").

Applicant has amended the rejected independent claims 38, 54 and 68 so as to require a carboxylic acid component comprising a mixture of two or more C<sub>5</sub>, C<sub>6</sub>, C<sub>7</sub>, C<sub>8</sub> and C<sub>9</sub> linear monocarboxylic acids, as opposed to simply any single carboxylic acid having from 5 to 18 carbon atoms. In light of the amendments made herein, Applicant submits that the Examiner's rejection under §103(a) is overcome. The rejected independent claims 38, 54 and 68 now include a reference to a mixture of two or more C<sub>5</sub>, C<sub>6</sub>, C<sub>7</sub>, C<sub>8</sub> and C<sub>9</sub> linear monocarboxylic acids, previously referred to in dependent claims held by the Examiner to contain allowable subject matter.

Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

In Paper No. 3, the Examiner rejected claims 46-51, 62-66 and 76 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner contends that the rejected claims recite a mixture of monocarboxylic acid and dicarboxylic acid, and that such a mixture is not supported by the disclosure. On this basis the Examiner argues that the claims contain new matter. Accordingly, the Examiner rejects the claims under §112, first paragraph and also objects to the Specification, in accordance with §608.01(o) of the M.P.E.P., as failing to provide antecedent basis.

Applicant strenuously, but respectfully, traverses this rejection and the accompanying objection for the following reasons.

First, Applicant's Specification clearly and specifically incorporates by reference the entire contents of U.S. Pat. No. 5,021,179, at page 3, lines 20-22. Applicant's Specification contains the clear reference to U.S. Pat. No. 5,021,179, in regard to the use of the acid components disclosed therein to make the polyol esters disclosed in the instant Specification.

Applicant would like to reiterate that such an incorporation by reference is both allowed and accepted as accomplishing the same thing as had the actual text been incorporated into the Specification. The M.P.E.P. clearly states:

Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. (M.P.E.P., §2163.07(b), 8<sup>th</sup> Ed. (*emphasis added*)).

The rules for incorporation by reference are more specifically provided for in Chapter 600 of the M.P.E.P., wherein it provides:

An application as filed must be complete in itself in order to comply with 35 U.S.C. 112. Material

nevertheless may be incorporated by reference, *Ex parte Schwarze*, 151 USPQ 426 (Bd. App. 1966).

An application for a patent when filed may incorporate "essential material" by reference to (1) a U.S. patent, (2) a U.S. patent application publication, or (3) a pending U.S. application, subject to the conditions set forth below. "Essential material" is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112). (M.P.E.P., §608.01(p)).

Accordingly, Applicant submits that the incorporation of U.S. Pat. No. 5,021,179, by reference in the instant Specification is fully compliant with Title 35, §112, and the rules, as further described in the M.P.E.P.

Thus, given that the contents and teachings of U.S. Pat. No. 5,021,179 ("the '179 patent") are fully incorporated into the instant Specification, Applicant would like to draw the Examiner's attention to column 3, lines 22-39 of the '179 patent, specifically, lines 24-26, wherein a preferred embodiment is described, as preferably, "react[ing] a single kind of alcohol [] with a mixture of monovalent and divalent acids . . ." (See, the '179 patent, col. 3, lines 22-39). Mixtures of monocarboxylic acids and dicarboxylic acids are described specifically, and broadly, throughout the '179 patent, for example, at col. 3, lines 4-10, lines 40-41, and at col. 4, lines 13-25.

Applicant submits that a carboxylic acid component containing both monocarboxylic and dicarboxylic acid constituents is fully supported by the incorporation of the '179 patent.

Accordingly, Applicant respectfully requests reconsideration by the Examiner and withdrawal of both the rejection under 35 U.S.C. §112, first paragraph, and the corresponding objection to the Specification..

In view of the remarks set forth above, Applicant submits that all pending claims fully comply with the requirements of 35 U.S.C. §112, first paragraph. Furthermore, in view of the amendments made herein, Applicant submits that all pending claims patentably distinguish over the prior art of record and known to Applicant, either alone or in combination.

Accordingly, reconsideration, withdrawal of the rejections and a Notice of Allowance are respectfully requested.

Respectfully submitted,

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By: 

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(Date)

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Claims 41-42, 44-45, 49-51, 57-58, 60-61, 65-66, 71-72 and 74-75, have been canceled, without prejudice.

Claims 38, 43, 46, 54, 59, 62, 68, 73 and 76, have been amended, without prejudice, as follows:

--38. (Amended) A shock absorber comprising a cylinder, the cylinder defining a chamber therein and containing a fluid; a piston rod sealingly projecting into the cylinder, the piston rod being axially displaceable with respect to the cylinder; a piston attached to the piston rod, the piston being slidably disposed within the cylinder to sealingly divide the cylinder into a first chamber and a second chamber; a passageway disposed in at least a portion of the piston providing for fluid communication between the first and second chambers; wherein the fluid comprises a biodegradable polyol ester, said polyol ester having a polyol component and a carboxylic acid component, the polyol component comprising a hindered polyol and the carboxylic acid component comprising a mixture of two or more C<sub>5</sub>, C<sub>6</sub>, C<sub>7</sub>, C<sub>8</sub> and C<sub>9</sub> linear monocarboxylic acids having from about 5 to about 18 carbon atoms; and wherein said fluid is at least 80% biodegradable.--

--43. (Amended) The shock absorber according to claim 38, wherein the ~~monocarboxylic acid~~ carboxylic acid component further comprises a branched carboxylic acid having from about 5 to about 10 carbon atoms.—

--46. (Amended) The shock absorber according to claim 38, wherein said carboxylic acid component further comprises a mixture of a ~~monocarboxylic acid~~ and a dicarboxylic acid.—

--54. (Amended) A shock absorber containing a hydraulic fluid for dampening movement of associated mechanical members therein, said hydraulic fluid comprising a biodegradable polyol ester, said polyol ester having a polyol component and a carboxylic acid component, the polyol component comprising a hindered polyol and the carboxylic acid component comprising a mixture of two or more C<sub>5</sub>, C<sub>6</sub>, C<sub>7</sub>, C<sub>8</sub> and C<sub>9</sub> linear monocarboxylic acids having from about 5 to about 18 carbon atoms; and wherein said fluid is at least 80% biodegradable.--

--59. (Amended) The shock absorber according to claim 54, wherein the monocarboxylic acid carboxylic acid component further comprises a branched carboxylic acid having from about 5 to about 10 carbon atoms.--

--62. (Amended) The shock absorber according to claim 54, wherein said carboxylic acid component further comprises a mixture of a monocarboxylic acid and a dicarboxylic acid.--

--68. (Amended) A method of dampening the movement of a mechanical member disposed within a shock absorber, wherein said mechanical member defines a first chamber and a second chamber within the shock absorber and includes at least one passageway for fluid communication between the first and second chambers; said method comprising providing a hydraulic fluid in the first and second chambers, the hydraulic fluid comprising a biodegradable polyol ester, said polyol ester having a polyol component and a carboxylic acid component, the polyol component comprising a hindered polyol and the carboxylic acid component comprising a mixture of two or more C<sub>5</sub>, C<sub>6</sub>, C<sub>7</sub>, C<sub>8</sub> and C<sub>9</sub> linear monocarboxylic acids having from about 5 to about 18 carbon atoms, wherein said fluid is at least 80% biodegradable, such that passage of the hydraulic fluid through the at least one passageway dampens the movement of the mechanical member.--

—73. (Amended) The method according to claim 6874, wherein the monocarboxylic acid carboxylic acid component further comprises a branched carboxylic acid having from about 5 to about 10 carbon atoms.—

—76. (New) The method according to claim 68, wherein said carboxylic acid component further comprises a mixture of a monocarboxylic acid and a dicarboxylic acid.—